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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,404	04/15/2004	Rainer Knapp	KNAPP3	7685

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BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

EXAMINER

BURCH, MELODY M

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,404

Applicant(s)

KNAPP ET AL.

Examiner

Melody M. Burch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4373707 to Molders in view of US Patent 3089391 to Raleigh.

Re: claims 1-29. Molders shows in figure 1 an adjustable length spring, comprising a casing 12 which has a central longitudinal axis and is filled with a pressure fluid; a guide and seal unit 16,18 which closes the casing at a first end thereof; a piston rod 22 which has an outer end and is extended through, and sealed towards the guide and seal unit out of the first end of the casing; a piston 24 which is guided in, and sealed towards the casing and connected with the piston rod; a first sectional casing chamber 26 which is formed between the piston and the guide and seal unit, a second sectional casing chamber 28 which is defined by the piston and faces away from the first sectional casing chamber, a valve 36,34 which is disposed in a vicinity of the piston for interconnection of the sectional casing chambers, the valve having a valve pin 36, which is displaceable along the central longitudinal axis, for actuation of the valve from outside the casing as shown; and at least one element shown radially outside of the end of the lead line of 38, which is disposed between the piston and the first end of the casing,

which encircles the piston rod as shown, which supports itself on a side opposite the guide and seal unit, and which counteracts any extension of the piston rod for at least part of a length of extension.

Molders fails to disclose the limitation of the element being a spring element that springly counteracts any extension.

Raleigh teach in figure 2 the limitation of a spring element 43 that springly counteracts any extension of the piston rod connected to element 40.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the element of Molders to have included a spring element, in view of the teachings of Raleigh, in order to resiliently counteract extension of the piston rod to improve ride "feel" and prevent harsh impacts.

Response to Arguments

3. Applicant's arguments filed 11/18/05 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the object of the claimed invention, which is to provide a stop that springily counteracts any extension of

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the piston rod relative to the casing, is taught by the Raleigh reference. Examiner directs Applicant's attention to col. 2 lines 34-37 and figure 2. In the cited sections of the patent, Raleigh teaches the use of at least one spring element in the form of at least one saucer spring 43 springliiy counteracting any extension of the piston rod connected to piston 40 by "resiliently stopping rearward displacement." Examiner notes that the rearward displacement in figure 2 of Raleigh is an extension of the piston rod relative to the casing 36. Therefore, it is unclear how Applicant can conclude that there is no teaching or showing in either Molders or Raleigh for combining the buffer mechanism of Raleigh (used to resiliently stop excessive displacement/extension of a piston rod with respect to a casing) with the piston cylinder assembly of Molders (in which there is displacement/extension of a piston rod with respect to a casing). Examiner maintains that one of ordinary skill in the art would have looked to the teachings of Raleigh to modify the piston cylinder assembly of Molders to include at least one spring arranged as taught by Raleigh to resiliently stop excessive displacement/extension of the piston rod to improve ride "feel".

In response to applicant's argument that one would have to "integrate the whole buffer mechanism into the gas spring disclosed in Molders in order to resiliently stop the longitudinal displacement of the piston rod of the gas spring", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Examiner maintains that the combined teachings would have suggested to one of ordinary skill that springs may be incorporated in the piston cylinder device to resiliently counter extensions to improve ride "feel".

Examiner also maintains that the incorporation of the teaching of the spring arrangement used to avoid a rigid stop would by virtue of its existence within the piston cylinder assembly also provide an additional lift of stroke to the same extent as Applicant's spring arrangement.

Accordingly, the rejections have been maintained.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mmb
February 1, 2006

Melody M. Burch
Melody M. Burch
Primary Examiner
Art Unit 3683
2/1/06